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Dated: June 14, 2005
Amendment

REMARKS/ARGUMENTS

Claims 10-16 have been withdrawn, without prejudice, from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected species.

The Examiner has objected to the drawings. Examiner's first objection is based upon none of the figures including a cellular telephone as claimed in claim 6. Applicant has canceled claim 6 rendering this objection moot. In addition, the Examiner is requiring a replacement drawing for Figure 3 with the notation "Fig. 3". Applicant includes herewith such a replacement drawing in response to Examiner's objection and in compliance with 37 CFR 1.121(d). As such Applicant requests the withdrawal of this objection.

The Examiner has also objected to the abstract of the disclosure because it contains the word "invention". Applicant has amended the specification to eliminate the word "invention" and therefore requests removal of the associated objection. No new matter has been introduced as a result of Applicant's amendment to the abstract.

The Examiner has rejected claims 1-3 and 7 under 35 U.S.C. 103(a) as being unpatentable over Albertoni (U.S. Pat. No. 1,473,393) in view of Fascenelli, Jr. et al. (U.S. Pat. No. 5,690,365). The Examiner takes the position that Albertoni discloses a label portion, a flexible cord and a bead for securing the flexible cord to the object. Examiner further asserts that although Albertoni does not disclose the claimed element of a label portion formed from heat shrinkable material, the same

is disclosed by Fascenelli, Jr. and further that it would have been obvious to modify the Albertoni disclosure by making the label from a heat shrinkable material.

Applicant respectfully traverses this rejection and points out to Examiner that as an initial matter, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In re Geiger (CAFC 1987) 815 F2d 686, 2PQ2d 1276; In re Fine (CAFC 1988), 5 USPQ2d 1596. A careful review of Albertoni itself provides no such suggestion or incentive to that person skilled in the art seeking to improve.

Additionally, Applicant asserts that Albertoni does not, in fact, disclose a "bead" as claimed in the present application. On the contrary, the Albertoni disclosure employs a "clasp" rather than a bead along the flexible cord. Applicant points out that this is more than a semantic distinction in that, the Albertoni device requires the tying of a knot in the string behind the clasp in order to secure the clasp against the object (see lines 83-86). Through Applicant's use of a "bead" instead of a "clasp", Applicant's claimed device is able to avoid the requirement for tying a knot to secure the cord to the object. This is an important distinction in that a substantial advantage is obtained through avoiding the step of tying a knot and further because the "clasp" of Albertoni is functionally and structurally different from the bead claimed in the present invention. In particular, the Examiner is directed to lines 74-78 of the Albertoni disclosure wherein the clasp is described as comprising "a strip of metal or other suitable material having its ends rolled back upon itself to form two parallel tubes or loops". Applicant asserts that this structure differs significantly from that of a conventional "bead".

As such, it is respectfully requested that the grounds for rejection of claim 1 under 35 U.S.C. 103 as being unpatentable over Albertoni (U.S. Pat. No. 1,473,393) in view of Fascenelli, Jr. et al. (U.S. Pat. No. 5,690,365) be removed. Similarly, since claims 2-3 and 7 incorporate all of the limitations of claim 1, it is respectfully requested that the grounds for rejection of these claims under 35 U.S.C. 103 also be removed.

The Examiner next rejects claim 8 under 35 U.S.C. 103(a) as being unpatentable over Albertoni (U.S. Pat. No. 1,473,393) in view of Fascenelli, Jr. et al. (U.S. Pat. No. 5,690,365) as applied to claim 1 and further in view of Arnt (U.S. Pat. No. 5,269,564). The Examiner takes the position that Albertoni in view of Fascenelli, Jr. teaches the basic inventive concept of claim 1 and although the claim 8 limitation of looping the flexible cord is absent, that concept is disclosed by Arnt and further that it would have been obvious to modify the Albertoni disclosure by looping the cord through a hole in the label portion and looping the flexible cord through itself.

For the same reasons stated above with respect to claims 1-3 and 7, Applicant respectfully traverses this rejection and points out first that it would not have been obvious to combine Albertoni, Fascenelli and Arnt since there is no suggestion to combine. Secondly, Albertoni in view of Fascenelli Jr. does not, in fact, disclose each of the limitations in claim 1 because it is missing the bead element as discussed above. As such, it is respectfully requested that the grounds for rejection of claim 8 under 35 U.S.C. 103 as being unpatentable over Albertoni in view of Fascenelli, Jr. et al. as applied to claim 1 and further in view of Arnt be removed.

The Examiner next rejects claims 1-3 and 7 under 35 U.S.C. 103(a) as being unpatentable over Flood (U.S. Pat. No. 2,488,280) in view of Sonderman (U.S. Pat.

No. 3,186,611) and Fascenelli, Jr. et al. (U.S. Pat. No. 5,690,365). The Examiner takes the position that Flood discloses all of the claimed elements in claim 1 of Applicant's invention except for making at least one member in the form of a bead and making the tag from a heat shrinkable material. Examiner further asserts that the bead is shown by Sonderman and that it would have been obvious to substitute the bead in Sonderman for the member K in Flood and further that it would have been obvious to substitute the heat shrinkable tag for the label portion disclosed in Flood.

Applicant respectfully traverses this rejection for much the same reasons as stated above with respect to the combination of Albertoni and Fascenelli. First, Applicant asserts that it would not have been obvious to combine the teachings of Flood and Sonderman much less all three teachings of Flood, Sonderman and Fascenelli. More particularly, the Sonderman device does not even pertain to a structure used for tagging an object. Instead, it is a device for adjustably holding a game call wherein no identification or tagging is involved. Thus, Applicant asserts that it could not reasonably be expected that a skilled artisan looking to improve on the tagging device of Flood would look to teachings in Sonderman which discloses a holding device as opposed to a tagging device.

Even assuming for argument's sake that it would have been obvious to combine these three references, which it is not, the combined claimed elements of claim 1 of Applicant's invention is still lacking in the combination of the three references. The Sonderman bead can not by any stretch of the imagination be said to be used for "securing said flexible cord to said object to be labeled". The bead in Sonderman is used for an entirely different purpose, namely to control the sizing of neck bight 5 and abut coiled spring 10 after it has been released (see column 2, lines 20-23 and column 2 lines 35-40). Bead 9 in Sonderman clearly does not

serve the purpose of holding anything in place much less securing the cord on which it rests to an object to be labeled.

As such, it is respectfully requested that the grounds for rejection of claim 1 under 35 U.S.C. 103 as being unpatentable over Flood in view of Sonderman and further in view of Fascenelli, Jr. et al. be removed. Similarly, since claims 2-3 and 7 incorporate all of the limitations of claim 1, it is respectfully requested that the grounds for rejection of these claims under 35 U.S.C. 103 also be removed.

Examiner further rejects claim 5 under 35 U.S.C. 103(a) as being unpatentable over Flood in view of Sonderman and Fascenelli, Jr. as applied to claim 1 and further in view of Harris. In view of Applicant's argument above with respect to claim 1 and Flood and Sonderman, the dependency of claim 5 on claim 1 and further the lack of a teaching to combine these references, Applicant respectfully requests that this rejection be removed.

Examiner further rejects claim 6 under 35 U.S.C. 103(a) as being unpatentable over Flood in view of Sonderman and Fascenelli, Jr. as applied to claim 1 and further in view of Reed. In view of Applicant's argument above with respect to claim 1 and Flood and Sonderman, the dependency of claim 6 on claim 1 and further the lack of a teaching to combine these references, Applicant respectfully requests that this rejection be removed.

Examiner further rejects claim 8 under 35 U.S.C. 103(a) as being unpatentable over Flood in view of Sonderman and Fascenelli, Jr. as applied to claim 1 and further in view of Arnt. In view of Applicant's argument above with respect to claim 1 and Flood and Sonderman, the dependency of claim 8 on claim 1 and further the lack of a teaching to combine these references, Applicant respectfully requests that this rejection be removed.

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Examiner further rejects claims 5, 6 and 9 under 35 U.S.C. 103(a) as being unpatentable over Flood in view of Sonderman and Fascenelli, Jr. as applied to claim 1 and further in view of Paulson. In view of Applicant's argument above with respect to claim 1 and Flood and Sonderman, the dependency of claims 5, 6 and 9 on claim 1 and further the lack of a teaching to combine these references, Applicant respectfully requests that this rejection be removed.

Finally, Examiner rejects claims 1-4 and 7 under 35 U.S.C. 103(a) as being unpatentable over Sloane (U.S. Pat. No. 2,449,727) in view of Strykower (U.S. Pat. No 2,572,889) and Fascenelli, Jr. The Examiner asserts that Sloane discloses all elements of Applicant's claim 1 except a bead which Examiner asserts is present in Strykower in the form of elements 20, 23, and 24 which Examiner further asserts are present for securing the cord to an object. Examiner further asserts that it would have been obvious to modify Flood (it is assumed Examiner means Sloane) with the cord and bead arrangement taught by Strykower. Finally, the Examiner states that it would have been obvious to combine all of these teachings with the heat shrinkable tag of Fascenelli, Jr.

Applicant respectfully traverses this rejection for much the same reasons as stated above with respect to the previous combinations cited by Examiner for rejecting these claims. First, Applicant asserts that it would not have been obvious to combine the teachings of Sloane and Strykower much less all three teachings of Sloane, Strykower and Fascenelli. Applicant asserts that it could not reasonably be expected that a skilled artisan looking to improve on the tagging device of Sloane would look to teachings in Strykower which discloses a holding device as opposed to a tagging device.

Secondly, a careful reading of Strykower shows that none of elements 20, 23, or 24 meet the limitation of being "a bead for securing a flexible cord to an object to be labeled". There is nothing to be labeled in Strykower since it is for carrying an article and there is no mention or reference to a label or tag.

As such, it is respectfully requested that the grounds for rejection of claim 1 under 35 U.S.C. 103 as being unpatentable over Sloane in view of Strykower and further in view of Fascenelli, Jr. et al. be removed. Similarly, since claims 2-4 and 7 incorporate all of the limitations of claim 1, it is respectfully requested that the grounds for rejection of these claims under 35 U.S.C. 103 also be removed.

The references cited by the Examiner as being of interest has been reviewed and found not to be pertinent to the issue of the patentability of the instant claims.

In conclusion, based upon the above, it is respectfully submitted that all claims remaining in this application (claims 1-9) are in condition for allowance. Prompt notification of allowance is respectfully solicited.

Respectfully submitted,

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